


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|---|--------------------------------|
| In re Patent of: Li, X. et al. | Examiner: Not yet known |
| Serial No: 10/500,932 | Art Unit: Not yet known |
| Filed: July 8, 2004 | Attorney Docket No. TRA-029.01 |
| For: <i>Efficient Liposomal Encapsulation</i> | |

Mail Stop PCT
 Commissioner for Patents
 Office of PCT Legal Administration
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 Alexandria, VA 22313-1450
ATTN: Office of PCT Legal Administration

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 30 JAN 2007
 Legal Staff
 International Division

| Certificate of Mailing | |
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| I hereby certify that the instant "Response to Decision on Petition" is being deposited on the date set forth below with the U.S. Postal Service as First Class Mail in a postage-prepaid envelope addressed to: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. | |
| <u>1-24-07</u> Date of Signature and Mail Deposit | By: <u></u> John Barretto |

RESPONSE AND REQUEST TO DECISION OF PETITION

Dear Sir or Madam:

In response to the Decision on Petition dated January 5, 2007, which withdrew abandonment of the above referenced application and is included in this correspondence, Applicants submit the requested declaration executed by Tong Shangguan in accordance with 37 CFR 1.497(a)-(b) and an explanation pursuant to Manual of Patent Examining Procedure (MPEP) § 201.03, along with a request that Tong Shangguan be added as an inventor in the above referenced application.

In accordance with MPEP § 201.03, the following are included with this response:

1. a declaration executed by Tong Shangguan in accordance with 37 CFR § 1.63;

2. a statement by Tong Shangguan stating that the inventorship error occurred without any deceptive intent on her part;

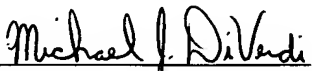
3. this request to correct inventorship which requests that Tong Shangguan be added as an inventor in the above referenced application; and

4. a check for \$130.00 in accordance with 37 C.F.R. § 1.17(i).

No additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any over payments to our Deposit Account No. 06-1448. A duplicate copy of this paper is enclosed.

Patent Group
FOLEY HOAG LLP
155 Seaport Boulevard
Boston, MA 02210
(617) 832-1000

Respectfully submitted,
FOLEY HOAG LLP


Michael J. DiVerdi, Ph.D.
Registration No. 51,620
Attorney for Applicants

Date: January 24, 2007



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Boston, MA 02210-2600

Response & Recl-
DOCKETED
DUE: 2/5/07 - Final

In re Application of
LI et al.
Application No.: 10/500,932
PCT No.: PCT/US03/00377
Int. Filing Date: 08 January 2003
Priority Date: 09 January 2002
Attorney Docket No.: TRA-029.01
For: EFFICIENT LIPOSOMAL
ENCAPSULATION

DECISION ON PETITION

This decision is issued in response to applicants' "Petition for Withdrawal of Holding of Abandonment" filed 02 November 2006, which is being treated as petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 08 January 2003, applicants filed international application PCT/US03/00377 which claimed a priority date of 09 January 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 09 July 2004.

On 08 July 2004, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application, and an application data sheet.

On 16 February 2005, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 12 July 2006, the United States Elected Office mailed a Notification of Abandonment under 37 CFR 1.495 (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 16 February 2005 within the time period set therefor.

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On 02 November 2006, applicants filed the present petition which was accompanied, among other things: a copy of the declaration and power of attorney filed 19 September 2005; a post card receipt dated 19 September 2005; and a transmittal letter dated 19 September 2005.

DISCUSSION

A. Petition for Withdrawal of Holding of Abandonment

Applicants state in their present petition that a declaration was received at the United States Patent and Trademark Office on 19 September 2005. A review of the present application reveals that the declaration filed 19 September 2005 is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicants have provided a copy of their date-stamped filing receipt. The receipt identifies the application by applicant, title of invention, and application number. The receipt itemizes a declaration executed by the inventors. The receipt is stamped "Rec'd. OIPE SEP19, 2005" across its face is sufficient to indicate that the declaration was in fact received in the Office on 19 September 2005.

B. Defective Declaration

The declaration executed by Tong Shangguan is defective and is insufficient to satisfy the oath or declaration requirement of 35 CFR 371(c)(4) for entry into the national stage in the United States of America. Specifically, the declaration submitted includes an alteration that has not been initialed and dated by the inventor. (See MPEP §605.04(a) and 37 CFR 1.52(c)) Further, it appears that the declaration has been altered to correct the inventor's name. If this is the case, an explanation pursuant to Manual of Patent Examining Procedure §201.03 or §605.04(a) is required.

CONCLUSION

Applicant's petition for withdrawal of holding of abandonment under 37 CFR 1.181 is GRANTED.

A proper response must be filed within **ONE MONTH** from the mail date of this decision and must include a declaration in compliance with 37 CFR 1.497(a)-(b) executed by Tong Shangguan and an explanation pursuant to Manual of Patent Examining Procedure §201.03 or §605.04(a). No extensions of this time limit may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

JAN. 23. 2007

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PTO/SB/01A (09-04)

Approved for use through 07/31/2008. OMB 0851-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention Efficient Liposomal Encapsulation

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
- ☒ Application No. 10/500,932, filed on 07/08/04.
- ☐ as amended on _____ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the National or PCT International filing date of the continuation-in-part application.

All statements made herein of my/own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)

Inventor one: Xingong Li

Signature: _____ Citizen of: China

Inventor two: Tong Shangquan

Signature: Tong Shangquan Citizen of: US

Inventor three: Alla Polozova

Signature: _____ Citizen of: Canada

Inventor four: Walter R. Perkins

Signature: _____ Citizen of: US

Inventor five: Paul R. Meers

Signature: _____ Citizen of: US

☐ Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 minute to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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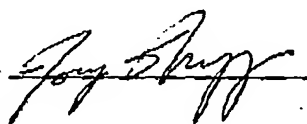
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| Serial No: 10/500,932 | Art Unit: Not yet known |
| Filed: July 8, 2004 | Attorney Docket No. TRA-029.01 |
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STATEMENT BY TONG SHANGGUAN

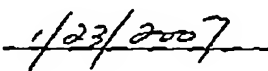
I, Tong Shangguan, hereby state;

1. I am an inventor of some or all of the subject matter claimed in the above identified patent application.
2. The error of my not being named as an inventor on the above identified patent application was not done with any deceptive intent on my part.
3. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and that such willful false statements may jeopardize the validity of the above identified patent.

Tong Shangguan



Date





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